

REMARKS

Claims 1-12, 15-24, 26-32 and 34-40 are currently pending in the application. By this amendment, claims 1, 15, 18, 24 and 26-29 are amended. Support for the amendments can be found in the claims as previously presented and at pages 14, 16 and 17, and in figures 4a-4e. No new matter is added. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

Rejection under 35 U.S.C. 112, 2nd Paragraph

Claims 7 and 40 were rejected under 35 U.S.C. 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner is of the opinion that "remaining sections of the approach section" is inferential and lacking proper antecedent basis. Applicants note that "remaining sections of the approach section" does not lack antecedent basis. First, the phrase "remaining sections" is first recited in claims 7 and 40. Accordingly, this phrase does not lack any antecedent basis. Second, the phrase "the approach section" finds support in claim 6 and claim 39, which claims 7 and 40 depend thereon, respectively.

Accordingly, Applicants request that the rejection of claims 7 and 40 be withdrawn.

35 U.S.C. §102 Rejection

Claims 1, 4, 6, 8-12, 14-19, 24, 25, 28, 30-32, 34 and 38-40 were rejected under 35 U.S.C. §102(b) for being anticipated by U. S. Patent No. 4,169,602 issued to Heddon. This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

Preliminary Matters

Applicants wish to thank the Examiner for a thorough explanation of his position. This explanation has assisted Applicants' undersigned representative to more thoroughly understand the Examiner's position and respond accordingly. However, Applicants note that the Examiner has not addressed each and every feature of the claimed invention. For example, it does not appear that the Examiner considered features of, for example, 38. More specifically, the Examiner did not address the following features in the §102(b) rejection:

...the short side edges of abutting wooden floors of the plurality of wooden floors having interleaved finger joints bonded together by an adhesive applied thereon

The Examiner also does not address all of the features associated with the foul line. For example, the Examiner does not appear to address the features of claim 14 which are now incorporated into claim 1. Specifically, the Examiner does not address the contrasting material of the foul line. Also, the Examiner does not address, amongst other features, the dimensions of the approach lane in claims 16 and 18.

For these reasons, Applicants submit that a clear issue was not developed between the Examiner and Applicants. As such, the next Office Action, which should clarify this issue, *cannot* be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully submit that the Examiner may not make the next action final, as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant".

Claim 1

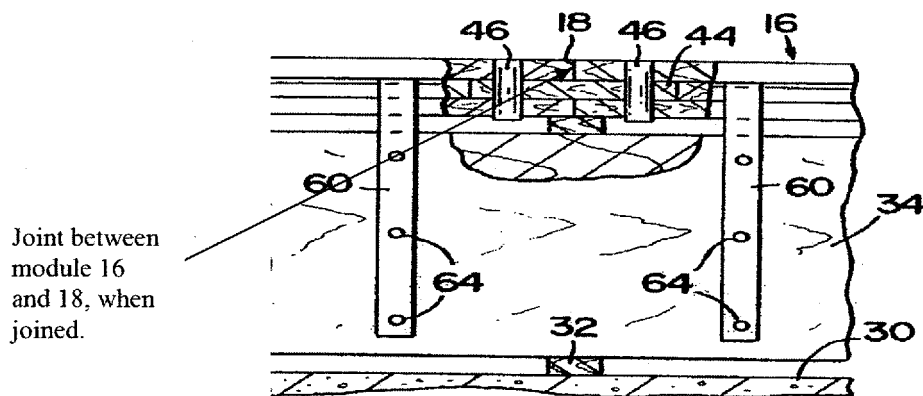
Claim recites, in pertinent part:

A prefabricated flooring system adapted for use in a bowling center, comprising an integrated foul line of contrasting material bonded to an edge of the preformed section of wooden boards substantially perpendicular to the longitudinal axis, wherein the integrated foul line is bonded to a milled portion in the edge of the plurality of wooden boards.

Applicants submit that Heddon does not show these features. More specifically, Heddon does not show an integrated foul line with contrasting material, much less the foul line bonded to a milled portion in the edge of the wooden boards. Also, Heddon does not show an integrated foul line of contrasting material bonded to an edge of the preformed section of wooden boards

substantially perpendicular to the longitudinal axis. Instead, Heddon merely shows a foul line 18 that is made from a joint of an approach lane module 20 and lane module 16.

More specifically, in the rejection of claim 14 (the contents of which are incorporated into claim 1), the Examiner is of the opinion that Heddon shows a foul line bonded to a groove as shown in Fig. 12. Applicants disagree with the Examiner. Applicants submit that fig. 12 does not show a groove, much less a foul line bonded to a groove. Fig. 12 also does not show an integrated foul line of contrasting material bonded to an edge of the preformed section of wooden boards substantially perpendicular to the longitudinal axis. Instead, fig. 12 clearly shows a portion of the approach lane module 20 and bowling lane module 16 in an exploded view (prior to installation). In this view, Heddon shows that the foul line 18 consists of the joint made between the approach lane module 20 and the bowling lane module 16. As best shown in fig. 3, which is reproduced below, the foul line 18 consists of the joints of the module, and would be of the same material of the modules 16 and 20. That is, the foul line 18 is not (i) placed in a groove (or milled section), (ii) is not shown to be of a contrasting material, and (iii) is not an integrated foul line bonded to an edge of the preformed section of wooden boards substantially perpendicular to the longitudinal axis.



In fact, Applicants submit that Heddon specifically notes the use of inlays with reference to ball guides (See, col. 4, lines 38-39). However, the very next sentence, Heddon discloses the

use of the foul line 18, but is completely silent as to such foul line being inlaid. For this reason, it is apparent that Heddon did not contemplate the foul line 18 to be inlaid, which would add to the complexity and cost of the Heddon system. Instead, Heddon clearly only discloses and contemplates the foul line 18 to be a joint between two modules 16, 20.

Claim 18

Claim 18 is amended into independent form. Claim 18 recites, in pertinent part:

... wherein the preformed section of wooden boards is a prefabricated sectioned approach section totally filling an area of the bowling lane in addition to gutter area.

First, Applicants submit that the Examiner has not considered this feature. Second, Applicants submit that this feature is not shown in Heddon. Instead, Heddon specifically shows that the approach lane module 20 is of the same size as the remaining modules 10, 12, 14, 16. In fact, the approach lane module 20 in Heddon is specifically designed to be the same size (width) as the remaining modules 10, 12, 14, 16. See, e.g., paragraph spanning cols. 5 and 6. Additionally, Heddon specifically describes an approach fill means used to bridge the area between approach modules created by the gutters. Specifically, col. 6, lines 6-16 discloses:

Referring now to FIGS. 4 and 6, approach fill means 28 will be described. Approach fill means 28 is sixteen feet in length as are all the other approach and lane modules. The approach fill means is designed to bridge the gap between adjacent approach modules. This gap is created by the spacing required for the insertion of the gutters and ball returns between adjacent bowling lanes. The approach fill means is designed to be readily insertable between adjacent approach modules after the approach modules have been secured to lane support structure 34.

Clearly, the approach module lane 20 does not totally fill an area of the bowling lane in addition to gutter area. Instead, the approach lane module 20 is the size of the space between the gutters.

Claim 24

Claim 24 recites, in pertinent part:

the prefabricated approach section having a thickness approximately the same as the bowling lane, which is a laminate floor.

Applicants submit that these features are not shown in Heddon.

More specifically, Heddon does not show a laminate floor, much less the approach section having a thickness approximately equal to a bowling lane which is a laminate floor. Instead, Heddon shows five modules 10, 12 14, 16 and 20 that are identical to one another. None of these modules can be considered a laminate floor; instead, the modules are prefabricated wooden floors. Laminate floors, on the other hand, have a special meaning in the art. For example, according to the Laminate Flooring Glossary at www.pmel.org/Flooring-Glossary.htm, laminate floors are defined as:

Laminate Flooring: Relatively new to North America, laminates have a dense fiberboard core with a paper pattern layer sealed under high pressure both top and bottom with a plastic-like substance. Sold as planks and panels in wood, stone, tile and other looks.

Similar definitions are provided at: 1) en.wikipedia.org/wiki/Laminate_flooring, 2) www.nalfa.com/glossaryEnglish.php, 3) www.bakerbros.com/contentpage.aspx, 4) www.remnantkingcarpets.com/Glossary.html, and 5) ezinearticles.com/

Applicants also note that laminate floors are much thinner than typical bowling floors. This is clearly described in the instant specification. For example, laminate floors can be a thickness of about ½ inch or less, which is unheard in bowling lane applications. In fact, at the

time of the invention of Heddon (May 12, 1978), laminate flooring of the type contemplated by the present invention were not even invented, much less in production.

Claim 38

Claim 38 recites, in pertinent part:

... the plurality of wooden boards each having a long side edge and a short side edge, the short side edges of abutting wooden floors of the plurality of wooden floors having interleaved finger joints bonded together by an adhesive applied thereon....

First, as noted above, the Examiner does not even address these features. Second, Applicants submit that these features are not shown in Heddon. In fact, Heddon appears to only suggest that the planks have flat sides, which can be glued together. Heddon clearly does not use interleaved finger joints, which add to the cost of manufacturing the modules. However, in the present invention, these joints are advantageous especially used with thinner boards.

Dependent Claims

Claims 4, 6, 8-12, 14-17, 19, 25, 28, 30-32, 34 and 39-40 are dependent claims, depending from distinguishable base claims. By virtue of these dependencies, these claims are also distinguishable.

Applicants respectfully request that the rejection over claims 1, 4, 6, 8-12, 14-19, 24, 25, 28, 30-32, 34 and 38-40 be withdrawn.

35 U.S.C. §103 Rejection

Claims 2, 3, 26 and 27 were rejected under 35 U.S.C. §103(a) for being unpatentable over Heddon. Claims 5 and 29 were rejected under 35 U.S.C. §103(a) for being unpatentable over Heddon in view of U. S. Patent No. 2,969,983 to De Vore. Claims 7 and 40 were rejected under

35 U.S.C. §103(a) for being unpatentable over Heddon and U.S. Patent No. 5,888,142 to Pierre. Claims 20, 21, 35 and 36 were rejected under 35 U.S.C. §103(a) for being unpatentable over Heddon and U.S. Patent No. 6,645,082 to Lessard. Claim 22 was rejected under 35 U.S.C. §103(a) for being unpatentable over Heddon and Sawdust Making 101. Claims 1-12, 17-32 and 35-40 were rejected under 35 U.S.C. §103(a) for being unpatentable over De Vore and Heddon. Claims 14-16 and 34 were rejected under 35 U.S.C. §103(a) for being unpatentable over De Vore and Heddon and U.S. Patent No. 5,348,513 to Heddon. These rejections are respectfully traversed.

Claims 2, 3, 5, 7, 20-22 26, 27, 29, 35, 36 and 40

Claims 2, 3, 5, 7, 20-22 26, 27, 29, 35, 36 and 40 are dependent claims, depending from distinguishable base claims. By virtue of these dependencies, these claims are also distinguishable.

Claims 2, 3, 26 and 27

The Examiner is of the opinion that the thickness of the boards are an obvious matter of design choice, and that such thickness has not been shown to be critical to Applicants' claimed invention by solving any particular problem or producing any unexpected results. This is not accurate. As noted above, the thickness of the prefabricated approach lane is advantageously used with laminate bowling lanes, which are of a smaller thickness than known wooden lanes. Also, the smaller thicknesses have been shown to save costs, etc.

Claims 20, 21, 35 and 36

The Examiner is of the opinion that the combination of Heddon and Lessard show the features of the claimed invention. Despite the teachings of Lessard, Applicants submit that one of skill in the art would not have combined the teachings of Heddon and Lessard to achieve the claimed invention. Specifically, Heddon teaches specifically to use straps for securing the modules to support structures 34. There is no indication, whatsoever, that Heddon would have

contemplated using drilled holes and plugs for securing the modules. This would have only added to the cost and time of installation.

Claim 22

With respect to claim 22, to the extent that the Examiner is taking Official Notice with regard to this claimed feature, Applicants remind the Examiner of MPEP 2144.03. MPEP 2144.03 provides the following guidance for rejections based upon official notice:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

...

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

...

The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made.

...

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

Applicants traverse the Examiner's finding of official notice, and submit that the alleged fact, i.e., "finger joint," is not capable of instant and unquestionable demonstration as being well-known in combination with the remaining features of the claimed invention. In this case, the Examiner has not provided any specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge. Instead, the Examiner has merely alleged that a fact is well known. Accordingly, Applicants traverse the taking of official notice, and respectfully request that the Examiner provide documentary evidence to support the allegation of fact in the next Official action.

Claims 1-12, 17-32 and 35-40

Claims 1, 19, 24 and 38 are independent claims. The arguments presented with regard to Heddon are incorporated herein. As noted above, Heddon does not show the features of these claims. In addition, as argued in the Appeal Brief filed on May 21, 2007, the contents of which are incorporated by reference herein, in their entirety, Applicants submit that De Vore does not show the features which are missing in Heddon.

Claim 1

De Vore does not show an integrated foul line of contrasting material bonded to an edge of the preformed section of wooden boards substantially perpendicular to the longitudinal axis,

wherein the integrated foul line is bonded to a milled portion in the edge of the plurality of wooden boards (claim 1). De Vore is silent as to this feature.

Claim 18

As to claim 18, Applicants submit that it would not have been obvious to combine the features of De Vore and Heddon. For example, Heddon specifically discloses and contemplates an approach lane module that is the width between the gutters, and then uses a filler approach means to fill the gap between adjacent approach lane modules. De Vore, on the other hand, does not show prefabricated lanes, and merely shows planks of wood that form the approach section. Although the separate boards fill an area of the bowling lane in addition to gutter area, there is no indication, whatsoever, that these separate boards can be part of a module that forms an approach lane. If there is to be any interpretation, these separate boards would merely be nothing more than filler approach means. To argue otherwise would be pure conjecture and impermissible hindsight.

Claim 24

De Vore does not show the prefabricated approach section having a thickness approximately the same as the bowling lane, which is a laminate floor (claim 24). De Vore does not show a Laminate. Instead, De Vore shows a wooden floor. Also, as noted in col. 4, De Vore contemplates the use of boards that are of a thicker height, than previously used.

Claim 38

De Vore does not show short edges that have interleaved finger joints (claim 38). Although the Examiner equates dovetails with interleaved finger joints, Applicants submit that these are not the same as understood by those of skill in the art and as presented in De Vore. Instead, De Vore clearly refers to dovetails as the planks of wood (e.g., reference numeral 17, 18) and the pattern that is made with the planks of wood. Also, the dovetails are clearly shown and described to be in the bowling lane, not the approach. Additionally, in De Vore, the short

edges of each plank of wood are merely being adhered to one another by an adhesive to an underlayment. Instead, the interleaved fingers of the present invention refer to the mechanism for locking panels together on the short edges.

Dependent Claims

Claims 2-12, 14-17, 19-23, 25-32, 34-37 and 39-40 are dependent claims, depending from a distinguishable independent claim. By virtue of these dependencies, these claims are also distinguishable.

Accordingly, Applicants respectfully request that the rejection over claims 1-12, 17-21 and 35-40 be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a long horizontal line extending to the right.

Andrew M. Calderon
Registration No. 38,093

Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
Telephone: 703-716-1191
Facsimile: 703-716-1180